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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/010,251 | 11/08/2001 | Leo Delson Wilhelm | 13929.1 | 5614 |
| 7590 | 12/02/2003 | | | |
| | | | EXAMINER | |
| | | | HALPERN, MARK | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1731 | |
| DATE MAILED: 12/02/2003 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/010,251 | Applicant(s) WILHELM, LEE DELSON |
| | Examiner Mark Halpern | Art Unit 1731 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 03 October 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 8-13,21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 8-13, 21, 22 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.

- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

- 1) Acknowledgement is made of Response received 10/3/2003.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

- A person shall be entitled to a patent unless –
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- 2) Claims 8-10, 12, 21-22, are rejected under 35 U.S.C. 102(b) as being anticipated by Cleveland (2,114,072).

Claims 8, 21: claim recites that an embossing roll will cause a percentage of fiber-to-fiber bonds broken in a center 0.02 mm thickness of a paper sheet to be less than a percentage of the fiber-to-fiber bonds broken within 0.02 mm of a paper surface of the same sheet, wherein said protuberances or depressions are sized at less than about 0.1 mm. In order to induce this paper property the surface of the present roll is structurally defined in the present Specification having protrusions of height of about 0.005 in. to about 0.04 in., and width from about 0.005 to about 0.50 in. (as recited on page 21, lines 3-15), and protrusions from about 0.004 in. to about 0.002 in., and width dimension of about 0.003 in. to about 0.001 in. (as recited on page 22, lines 7-17). Cleveland discloses a roll for papermaking having indentations of depth from about 0.002 in. to 0.02 in., and diameter from about 0.005 in. to 0.04 in. (Cleveland, pg. 2, col. 2,

lines 23-30). Cleveland discloses the dimensions that are in the same range as in present disclosure which causes the claimed effect on paper and thus, Cleveland anticipates the claimed invention.

Claims 9, 12: claims recite that the structure of the roll surface is such that surface deformations in the paper are visible and invisible to the unaided human eye. Cleveland discloses the dimensions that are in the same range as in present disclosure which causes the claimed effect on paper and thus, Cleveland anticipates the claimed invention.

Claim 10: the surface of the Cleveland roll is etched or sand blasted to obtain indentions (pg. 1, col. 2, lines 37-47).

Claim 22: claim recites that the roll height of embossing elements not used to form visually distinctive icons is less than one-half a thickness of a paper sheet to be embossed, wherein protuberances or depressions are sized at less than about 0.1 mm. Cleveland discloses the dimensions that are in the same range as in present disclosure which causes the claimed effect on paper and thus, Cleveland anticipates the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

- 3) Claims 11, 13, are rejected under 35 U.S.C. 103(a) as being unpatentable over Cleveland in view of Johnson (2,498,275).

Claim 11: Cleveland is applied as above for claim 8, Cleveland fails to disclose method of making depressions by stippling. Johnson discloses method of making depressions by stippling in a surface of a product (col. 9, lines 20-30 and Figures 25, 32). It would have been obvious, to one skilled in the art at the time the invention was made, to combine the teachings of Johnson and Cleveland, because such a combination would provide a means of creating delicate depressions in the roll of Cleveland.

Claim 13: claim recites that the structure of the roll surface is such that surface deformations in the paper are visible and invisible to the unaided human eye. Cleveland discloses the dimensions that are in the same range as in present disclosure and which causes the claimed effect on paper thus, Cleveland disclosure reads on the claimed invention.

Response to Amendment

- 4) Applicant's arguments filed 10/3/2003, have been fully considered but they are not persuasive.

Applicant alleges that the cited prior art, Cleveland, discloses a roll that has indentations, not indentations and protuberances.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies

(i.e., indentations and protuberances) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Cleveland discloses a roll for papermaking having indentations which reads on the present roll recited as having “protuberances or depressions”.

Applicant alleges that the Cleveland reference teaches of contacting the paper web having a water content of between 65 and 70 percent, thus under such condition disruption of bonds as claimed cannot take place.

In response to applicant's argument that Cleveland teaches of contacting the paper web having a water content of between 65 and 70 percent, thus under such condition disruption of bonds as claimed cannot take place, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

The use of the roll as disclosed by Cleveland does not structurally alter the roll. Cleveland anticipates the claimed invention.

Conclusion

- 5) **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

- 6) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Halpern whose telephone number is 703-305-4522. The examiner can normally be reached on Mon-Fri, (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 703-308-1164. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9309.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone no. is 703-308-0651.

MA

Mark Halpern
Patent Examiner
Art Unit 1731


PETER CHIN
PRIMARY EXAMINER